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PATREA L. PABST
PABST PATENT GROUP, LLP
400 COLONY SQUARE
SUITE 1200
1201 PEACHTREE STREET
ATLANTA, GA 30361

In re Application of :
David William Holden :
Serial No.: 09/714,602 : PETITION DECISION
Filed: November 16, 2000 :
Attorney Docket No.: RPMS 101 CON 3 :

This is in response to the renewed petition under 37 CFR 1.181, filed August 6, 2004, requesting review and reversal of the petition decision mailed August 6, 2004, in response to the petition filed March 10, 2004.

BACKGROUND.

A review of the file history shows that this application was filed using Utility Application Transmittal Form PTO/SB/05, provided by the Office. On the form, boxes 1, 3, 4, 6(b), 8(a) and (c), 9, 10, 13, 14, 16 and 17 are checked. Box 3 relates to the specification, box 4 to the drawings, and box 6(b) to the declaration. Box 6(b) clearly states that the declaration is a copy from a previous (parent) application (for a continuation/divisional application). Box 17 provides the continuation data required, specifically that this application is a continuation of prior application 09/201,945. The transmittal sheet is signed by Robert A. Hodges, one of the attorney's of record in the parent application. Furthermore, a review of the specification, claims and drawings show that they are identical to the original parent application papers. No subject matter has been added to the original specification or drawings by amendment or any other change. Only the claims have been amended by preliminary amendment. Thus the application satisfies the requirements of 37 CFR 1.63 in that the original papers are identical to the parent application. Furthermore, the declaration supplied with the application is signed by the inventor and dated 1996, showing it to be a copy of the original papers from the parent application. Such a declaration is acceptable only when the newly filed application is the same as the parent application. Therefore, applicant's claim of priority, as set forth in the transmittal letter, is proper and correct.

In the last Office action the examiner denied applicants claim for priority based on subject matter now claimed in the continuing application which is purportedly not supported by the original specification and claims. On this basis the examiner has also set forth a rejection of the claims under 35 U.S.C. 112, first paragraph as lacking support in the specification. This rejection is

perfectly proper. The examiner states in the Office action of 11/17/03, at page 2, first paragraph, "...the instant application contains additional subject matter not contained within the application to which priority is claimed..." and this necessitates denial of priority. No identification of additional subject matter in the specification is here made. On page 3, a further explanation is made stating that applicant has not complied with one or more conditions of 35 U.S.C. 120. The examiner then argues that the parent applications have no disclosure in their specifications of the currently claimed methods sufficient to comply with 35 U.S.C. 112. While this may be a true statement, it is insufficient to deny priority, but sufficient to reject the claims under 35 U.S.C. 112. The cure for such rejection is for applicant to amend the specification based on the disclosure in the newly added claims to provide proper support therefore and to redesignate the application as a CIP. The examiner's statement (last paragraph, page 4) the "This application repeats a substantial portion of prior Application No. 09/201,945, filed 12/1/98, and adds and claims additional disclosure not presented in the prior application" is only partly accurate. The entire specification and original claims of the prior application are presented as well as a preliminary amendment presenting new claims with a directive to amend or cancel some original claims. The preliminary amendment is not part of the original application on which a priority claim is being based and plays no part in determining whether the priority claim is proper. Whether the new claims in the preliminary amendment are properly supported by the original specification and claims is a consideration which must be reserved for 35 U.S.C. 112 only. Analogously, if applicant had filed a CPA (or RCE) request and amended the application by adding the same new claims (by preliminary amendment) no question of denial of priority would have been raised, only whether the claims satisfy the requirements of 35 U.S.C. 112.

The examiner in the same Office action objected to the Oath or Declaration as being defective due to the introduction of new subject matter. However, no new matter has been introduced to the original specification or claims. Therefore, no new declaration is required unless the specification is subsequently amended to provide proper support for subject matter now claimed which is unsupported by the original specification. Should this occur, a new declaration by the inventor would be required and the application would be designated a CIP.

It is noted that the merits of the examiner's rejections, as argued in the renewed petition are not addressed herein. Such arguments are appropriate for response to the outstanding Office action.

The renewed petition is **GRANTED**. Priority to applicant's parent applications is granted.

The application remains rejected in view of the outstanding Office action, mailed August 10, 2004, to which applicant must respond within the time period set, or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.



Jasemine C. Chambers
Director, Technology Center 1600